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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SA.

Office Action Summary

Application No.

10/625,056

Applicant(s)

CHEUNG, LING YUK

Examiner

Dr. Kailash C. Srivastava

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/22/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-32 are pending.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Group I – Claims 1-2, 5-9, 11, 15 and 29 drawn to a biological fertilizer composition comprising poultry manure and dried yeast cells that can fix nitrogen, decompose phosphorus, potassium, and antibiotics; can suppress growth of pathogens, overproduce ATP and growth factors, classified under Class 435, Subclass 171.
 - Group II – Claims 3-10 12-15, and 30 drawn to a second biological fertilizer composition comprising a plurality of dried yeast cells grown in electromagnetic fields of varying frequency and strength, classified under Class 435, Subclass 69.9 or 255.2.
 - Group III- Claims 16, 18, 20, 22 and 31 drawn to a method to prepare a biological fertilizer composition wherein first a mixture if yeast cells of varying physiological capabilities is cultured, and subsequently poultry manure is added to the said cultured yeast cell mixture, classified under Class 435, Subclass 254.2.
 - Group IV- Claims 17, 19, 21, 23 and 32 drawn to a second method to prepare a biological fertilizer composition by first preparing a mixture of yeast cells of different physiological capabilities by culturing said yeasts in electromagnetic fields of varying frequency and strength, and subsequently adding poultry manure to the said cultured yeast cell mixture, classified under Class 435, Subclass 173.1.
 - Group V- Claims 24-28 drawn to a method to enhance plant growth wherein a biological fertilizer prepared by mixing a mixture of yeast cells of different physiological capabilities with poultry manure is applied, classified under Class 504, Subclass 117.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions in Groups I-II are related to each other as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions in each of Groups I-II have separate utility. For example invention in Group I is a mixture of dried yeast capable of decomposing a variety of inorganic materials as well as complex organic materials with poultry manure. The invention ascribed to Group II

on the other hand is a mixture of poultry manure with yeast cells of different physiological activities grown under an electromagnetic field.

Inventions in Groups I-II are related to invention in Group V as product and use thereof. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product [MPEP § 806.05(h)]. The process of enhancing the plant growth may also be achieved with a non-biological fertilizer comprised essentially of synthetic organic and inorganic salts.

Inventions in Groups III and IV are related to inventions in Groups I-II as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed method to prepare the biological fertilizer may also be used to prepare any chemical. Likewise, the claimed biological fertilizer may also be prepped by other fermentation and mixing means.

Inventions in Groups III, IV and V are unrelated to each other because they are directed to different inventions, which are not connected in design, operation and/or effect. These methods are independent since they are not disclosed as capable of use together. They have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the two methods at the same time to practice just one method alone (MPEP § 806.04, MPEP § 808.01). In the instant case, different inventions disclosed in the claims encompassing inventions in Groups III and IV are each methods to make a fertilizer product, however, each one of them will not be simultaneously applicable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.

Species Election

4. This application contains claims directed to different compositions comprised of a variety of ingredients. The said ingredients are applicable to enhance the growth of a variety of group of plants. The said compositions are comprised of single ingredient (s) or mixtures of ingredients (e.g., yeasts of different genera and species grown under a variety of culture conditions).

Even though each of the above inventions relates to the same Class, the search for each of the above inventions is not co-extensive, particularly with regard to the literature search. This is because of the fact that the inventive groups discussed above incorporate numerous compositions and numerous ingredients within each of the same, single composition. For example, to conduct a literature search for invention in Group IV that is constituted of different ingredients and mixtures thereof, one would be searching for a total number of combinations that will be a factorial of at least 245 with each one of the ingredients up to ingredient number 1 (i.e. 245×244 , 245×243 , 245×242 , 245×241 , 245×240 ---- 245×1). With different conditions in claims 3-4 added to this, the number becomes 254 (i.e. 254×253 , 254×252 , 254×251 , 254×250 , ---- 254×1). Thus, this group alone will exert an enormous search burden on the Examiner. Therefore, if the applicant elects any one of Groups I-V above, the applicant must also make election of species by electing a single species from each of the following categories:

- One of components claimed in Claim 1 (IIa through IIIf),
- One of components claimed in Claim 2g through 2i,
- One of components claimed in Claim 3 (IIa through IIIf),
- One of components claimed in Claim 4g-4i,
- One of components claimed in Claim 6,
- One of components claimed in Claim 7, and
- One of components claimed in Claims 13 and 14, Or

5. If applicant elects any one of Groups I-V, the applicant is required under 35 U.S.C. 121 to elect a single disclosed species of composition, enumerating all ingredients therein for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently Claims I and 3 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species [MPEP § 809.02(a)].

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one

of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).


6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR §1.116; amendments submitted after allowance are governed by 37 CFR §1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR §1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §101, §102, §103, and §112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. §121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (571) 272-0926 Monday through Thursday. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Kailash C. Srivastava, Ph.D.
Patent Examiner
Art Unit 1651
(571) 272-0923

August 16, 2004


CHRISTOPHER R. TATE
PRIMARY EXAMINER